

## REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

By the foregoing amendment, the specification, the abstract of the disclosure and claims 1-6, 8-10, 11-13, 22-27, 29-31, 32-34 and 43-54 have been amended. Claims 7 and 28 have been canceled and new claims 59-62 have been added. No new matter has been added. Thus, claims 1-6, 8-10, 11-13, 22-27, 29-31, 32-34, 43-54 and 59-62 are pending in this application and subject to examination. Claims 14-21, 35-42 and 55-58 have been previously withdrawn.

### Abstract of the Disclosure

In the Office Action mailed May 6, 2005, the Abstract of the Disclosure is objected to because it reflects multiple inventions. The Abstract has been amended responsive to the objection. Reconsideration and withdrawal of the objection are respectfully requested.

### Drawings

The Office Action objects to the drawings, based on the Examiner's position that figures 19-21, 23-26 and 28 "only show desired results that are attributed to other references on pages 47-52." See Office action, at page 3. The Applicants traverse this objection, as follows.

The Applicants respectfully submit that the Examiner's position that figures 19-21, 23-26 and 28 "only show desired results that are attributed to other references . . ." is not a proper basis for an objection to the drawings. Furthermore, the Applicants submit that the references cited on pages 47-52 of the specification, and incorporated

into the present application by reference, are directed to text-to-speech conversion programs and converting dictionary entries from text to speech. As indicated in the specification, figures 19-21, 23-26 and 28 are respectively directed to: a diagram of a main menu screen for presenting to a viewer voice emulation options for electronic books; a flow chart of a main menu routine; a flow chart of a manual text-to-speech routine; a diagram of a page of an electronic book; a diagram of a page of an electronic book illustrating selected text for conversion to speech; a flow chart of an automatic text-to-speech routine with an automatic page turn feature; a flow chart of an automatic text-to-speech routine with a manual page turn feature; and a diagram of a settings menu. Thus, the Applicants submit that figures 19-21, 23-26 and 28 and the subject matter depicted therein are completely different from the disclosure in the references cited on pages 49-52 of the specification.

Accordingly, the Applicants request reconsideration and withdrawal of the objection to the drawings.

### **Priority Claims**

The Applicants express their appreciation to the Examiner for directing their attention to the domestic priority claims under 35 U.S.C. §§ 119(e), 120 or 121. By this amendment, the priority claims described in the specification have been corrected. Submitted herewith is a Request for a Corrected Filing Receipt, indicating the appropriate corrections requested.

### **Specification**

The specification is objected to for informalities, based on the Examiner's position that the disclosure should be "properly limited to the claimed invention to avoid

extraneous subject matter." See Office Action, at page 3. The Summary Of Invention section has been deleted and replaced with a replacement section responsive to the objection. Reconsideration and withdrawal of the objection are respectfully requested.

**Claims 1-13, 22-34 and 43-54 are in Compliance with 35 U.S.C. § 112, 1<sup>st</sup> Par.**

Claims 1-13, 22-34 and 43-54 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Applicants respectfully traverse this rejection, as follows.

In making the rejection, the Examiner notes that "the applicant did not invent the process nor the combination of elements for conversion of text to speech since the details[,] as described in the specification[,] are attributed to prior art references." See Office Action, at page 4. The Applicants submit that the present invention is not directed to, and does not merely claim, text-to-speech conversion. Instead, the pending claims are directed to a method or apparatus "for **providing** text-to-audio conversion of an electronic book displayed on a viewer," as recited in claims 1, 8, 11, 22, 29 and 32, as amended, and, through dependency, in claims 2-6, 9-10, 12-13, 23-27, 30-31, 33-34 and 59-62. (Emphasis supplied). Amended claim 43 (and, thorough dependency, claims 44-50) is directed to "[a] method for electronically displaying a page of an electronic book on a viewer and permitting a user to request a text-to-audio function." Amended claim (and, thorough dependency, claims 52-54) is directed to "[a] screen for use in electronically displaying a page of an electronic book on a viewer and permitting a user to request a text-to-audio function."

The Applicants respectfully submit that none of the currently pending claims 1-13, 22-34 and 43-54 are directed to a method or apparatus for converting text to

speech, as the Office Action appears to assume. Accordingly, the applicants request reconsideration and withdrawal of the rejection.

**Claims 1-6, 8-13, 22-27, 29-34 and 59-62 Recite Patentable Subject Matter**

Claims 1, 8, 11, 22, 29 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,850,629 to Holm et al. (hereinafter "Holm") in view of "Mastering WORDPERFECT® 5.1 & 5.2 for Windows" by Simpson (hereinafter "Simpson"). It is noted that claims 1-6, 8-10, 11-13, 22-27, 29-31, 32-34 and 43-54 have been amended, claims 7 and 28 have been canceled, and new claims 59-62 have been added. To the extent the rejections remain applicable to the claims currently pending, the Applicants hereby traverse the rejections, as follows.

Nothing in the cited prior art, taken alone or in combination, discloses or suggests at least the combination of features of "selecting an electronic book for viewing from a list of available books; displaying a page of the selected electronic book on the viewer, the page including text; receiving a selection of text on the displayed page to be provided in audio; and providing at least a portion of the selected text in corresponding audio," as recited in amended method claims 1, 8, and 11, and in the parallel language of the corresponding amended apparatus claims 22, 29 and 32. Furthermore, not only do the references cited, alone or in combination, fail to disclose or suggest these features of the present invention, but, as discussed in more detail below, the general motivation statement relied upon to combine the references on page 6 of the Office Action is based on hindsight, and is therefore an insufficient showing of motivation.

For at least these reasons, the Applicants submit that claims 1, 8, 11, 22, 29, and 32 are allowable over the cited prior art. As claims 1, 8, 11, 22, 29, and 32 are allowable, the Applicants submit that claims 2-6, 9-10, 12-13, 23-27, 30-31 and 33-34, as well as newly added claims 59-62, each of which depends from one of allowable claims 1, 8, 11, 22, 29, and 32, are likewise allowable over the cited prior art.

**Claims 43-50 Recite Patentable Subject Matter**

Claim 43 is also rejected under 35 U.S.C. § 103(a) as being unpatentable over Holm in view of Simpson. It is noted that claims 1-6, 8-10, 11-13, 22-27, 29-31, 32-34 and 43-54 have been amended, claims 7 and 28 have been canceled, and new claims 59-62 have been added. To the extent the rejections remain applicable to the claims currently pending, the Applicants hereby traverse the rejections, as follows.

Nothing in the cited prior art, taken alone or in combination, discloses or suggests at least the combination of features of “selecting an electronic book for viewing from a list of available books on the screen; . . . and displaying a section within the screen for permitting the user to request a text-to-audio conversion of the identified text,” as recited in amended claim 43. Furthermore, not only do the references cited, alone or in combination, fail to disclose or suggest these features of the present invention, but, as discussed in more detail below, the general motivation statement relied upon to combine the references on page 6 of the Office Action is based on hindsight, and is therefore an insufficient showing of motivation.

For at least these reasons, the Applicants submit that claim 43 is allowable over the cited prior art. As claim 43 is allowable, the Applicants submit that claims 44-50,

each of which depends from allowable claim 43, are likewise allowable over the cited prior art.

**Claims 51-54 Recite Patentable Subject Matter**

Claim 51 is also rejected under 35 U.S.C. § 103(a) as being unpatentable over Holm in view of Simpson. It is noted that claims 1-6, 8-10, 11-13, 22-27, 29-31, 32-34 and 43-54 have been amended, claims 7 and 28 have been canceled, and new claims 59-62 have been added. To the extent the rejections remain applicable to the claims currently pending, the Applicants hereby traverse the rejections, as follows.

Nothing in the cited prior art, taken alone or in combination, discloses or suggests at least the combination of features of "a first section within the screen for selecting an electronic book for viewing; . . . and a third section within the screen for permitting the user to request a text-to-audio conversion of the identified text," as recited in amended claim 51. Furthermore, not only do the references cited, alone or in combination, fail to disclose or suggest these features of the present invention, but, as discussed in more detail below, the general motivation statement relied upon to combine the references on page 6 of the Office Action is based on hindsight, and is therefore an insufficient showing of motivation.

For at least these reasons, the Applicants submit that claim 51 is allowable over the cited prior art. As claim 51 is allowable, the Applicants submit that claims 52-54, each of which depends from allowable claim 51, are likewise allowable over the cited prior art.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of

obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *Id.* In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembicza*k, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that it would have been obvious for a person having ordinary skill in the art at the time the invention was made, "that the input could come from 'pages' of an 'electronic book' because a word processor is capable of displaying text in a page format." See, e.g., Office Action at page 6. The Applicants submit that this general motivation statement is based on hindsight, and is therefore an insufficient showing of motivation.

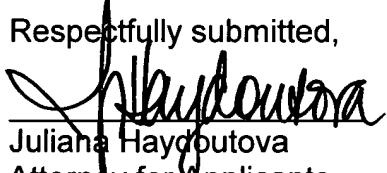
### **Conclusion**

For all of the above reasons, it is respectfully submitted that the claims now pending recite patentable subject matter. Accordingly, reconsideration and

withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referring to client-matter number 026880-00000(5265).

Respectfully submitted,  
  
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Enclosure: Request for Corrected Filing Receipt  
Petition for Extension of Time (3 months)